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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/351,857	07/13/1999	RICK W. LANDSMAN	UCC-1/CIP/D5	1323

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MICHAELSON AND WALLACE
PARKWAY 109 OFFICE CENTER
328 NEWMAN SPRINGS RD
P O BOX 8489
RED BANK, NJ 07701

EXAMINER

HONG, STEPHEN S

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 08/12/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/351,857

Applicant(s)

LANDSMAN ET AL.

Examiner

Stephen S. Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 2-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 2-4, 10-12, 18-21 and 26-28 is/are rejected.
- 7) ☐ Claim(s) 5-9, 13-17, 21-25 and 29-33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This office action is responsive to: prior art submitted on 10/25/99, 9/27/99, 1/12/00, 12/11/00, 1/8/01, 5/25/01, 1/29/02, 5/29/02 and 3/31/02 to the application filed on July 13, 1999.
2. Claims 2-33 are pending in this case. Claims 2 and 18 are independent claims.

Specification

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. As per independent claims 2 and 18, the phrase "...I the agent to the client computer such that the agent can be executed, under the browser ..." is indefinite, since it is unclear whether or not the execution is required to meet the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 2-4 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Himmel et al., U.S. Pat. No. 6,275,854 B1, 8/01.

As per independent claim 2, Himmel discloses the following claimed features:

- a processor and a memory connected to the processor for storing computer executable instructions (see FIG.2);
- receiving a request from the client computer to download to the client computer an agent for rendering an information object, the request being issued by the client computer in response to execution, through a browser situated and executing in the client computer, of advertising code embedded in a web page to be displayed by the browser (col.8, lines 5-29 "During the downloading of web page.. a java Applet ...is downloaded");

- downloads, in response to the request, the agent to the client computer such that the agent can be executed, under the browser, in the client computer for subsequently rendering the information object (col.8, lines 23-40).

As per dependent claim 3, Himmel discloses that the information object comprises a web advertisement and the code comprises advertising code (col.8, lines 20-30, "Advertisement control Module...").

As per dependent claim 4, Himmel teaches that the advertising code comprises a component which specifies the network server on which the agent resides, the network server being a distribution server (col.8, lines 55-68, since the user interaction information is sent back to the network server.).

Claims 18-20 recite substantially similar limitations as claims 2-4, respectively, and are similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 10-12 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Himmel et al.

As per dependent claims 10 and 11, Himmel does not explicitly disclose that the client computer issues a first and second applets, wherein the client computer issues first and second requests to the distribution server to download, to the client computer, the first applet being a Transition sensor applet. and a second applet being an Ad controller applet. Nevertheless, Himmel teaches that the client receives a Java Applet for controlling advertisements (col.8, line 22, "The Advertisement Control Module is responsible for displaying ...") and a javaScript for controlling transition (col.8, line 42+). Therefore, it would have been obvious to a person of ordinary skill at the time of the invention to envisaged the client computer issuing the first and second applets in Himmel, since Himmel explicitly taught the use of the two distinct applets to achieve the functionality.

As per dependent claim 12, Himmel teaches that the advertising code comprises a component which specifies the network server on which the agent resides, the network server being a distribution server (col.8, lines 55-68, since the user interaction information is sent back to the network server

Claims 26-28 recite substantially similar limitations as claims 10-12, respectively, and are similarly rejected under the same rationale.

Allowable Subject Matter

7. Claims 5-9, 13-17, 21-25, 29-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rakavy et al., U.S. Pat. No. 5,913,040, 6/99

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen S. Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday to Friday, 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9051 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Stephen Hong
Primary Examiner
Art Unit 2178
August 6, 2003